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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,984	03/11/2004	Noriki Tachibana	02860.0638-01	4623

22852 7590 09/23/2004

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EXAMINER	
DUONG, TAI V	

ART UNIT	PAPER NUMBER
2871	

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/796,984	TACHIBANA ET AL.	
	Examiner	Art Unit	
	Tai Duong	2871	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-20 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/492,404.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,731,357. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only differences between the instant claims and the patent claims are the omission of the polarizer from the patent claims and the use of the film as the polarizing plate protective film. The instant claims are broader in scope than the patent claims and are *anticipated* by the patent claims. Also, it would have been obvious to a person of ordinary skill in the art to broaden the patent claims by omitting the polarizer and the intended use of the film as the polarizing plate protective film from the patent claims when these limitations are considered as not important to the determination of the patentability of the claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7 and 8 are confusing because they recite the length of the film employed in a liquid crystal display (LCD) member is at least 1000 m or 1500 m. However, there is no known LCD member having a length of at least 1000 m.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Daecher et al.

Note column 17, lines 23-26, which identically discloses the claimed film having a thickness of 54 μm , a variation in the film thickness within $\pm$3.0% of the standard film thickness, and a retardation value of the film being below 10 nm. Also, see col. 1, lines 11-14.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 6-14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shuto et al in view of Daecher et al.

As to claims 1-4, 6, 11-14, 16 and 17, Shuto et al disclose a cellulose ester film, similar to that of the instant claims, having an average degree of substitution of 2.7 to 3.0 (col. 2, lines 49-61; col. 1, lines 14-18; col. 4, lines 21-24). Further, Shuto et al disclose that the film thickness can be 10 to 50 μm (col. 5, lines 61-67). The only differences between the film of Shuto and that of the instant claims are the variation in the film thickness within ±3.0% of the standard film thickness, and the retardation value of the film being below 10 nm. However, Daecher et al disclose that the above differences are known (col. 10, lines 1-10 and lines 52-58; col.17, lines 23-26). Thus, it would have been obvious to a person of ordinary skill in the art to employ a cellulose ester film having a film thickness within ±3.0% of the standard film thickness, and a retardation value of the film being below 10 nm for obtaining a film with low shrinkage, low birefringence and good surface quality, as disclosed by Daecher et al (col. 10, lines 1-2).

As to claims 7-10, it would have been obvious to a person of ordinary skill in the art to employ a film with tear strength of at least 7 g and a haze of no more than 0.55 for obtaining a protective film with good mechanical strength and endurance, and good optical clarity.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shuto et al and Daecher et al as applied to claim 1 above, and further in view of Schulz.

Schulz discloses that it was known to employ disclose a cellulose ester film a composition ratio of wood pulp cellulose/cotton linter cellulose (col. 1, lines 25-29). Thus, it would have been obvious to a person of ordinary skill in the art in view of Schulz to employ a cellulose ester film with a composition ratio of wood pulp cellulose/cotton linter cellulose=60/40 to 0/100 in terms of weight ratio for adjusting the desired viscosity of the film.

Claims 15 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shuto et al and Daecher et al as applied to claims 1, 4 and 14 above, and further in view of Aizawa et al and Conrad et al.

Aizawa et al disclose that it was known to employ protective films at both sides of the polarizer (col. 4, lines 6-10). Conrad et al disclose in Fig. 1 that it was known to employ both polarizers (16, 18) in a LCD. Thus, it would have been obvious to a person of ordinary skill in the art in view of Aizawa et al and Conrad et al to employ protective films at both sides of the two polarizers of the LCD for protecting the polarizers against adverse conditions.

Any inquiry concerning this communication should be directed to Tai Duong at telephone number (571) 272-2291.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

TVD

09/04

TOAN TON
PRIMARY EXAMINER